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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/763,642

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David Howell

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DLA PIPER US LLP  
2000 UNIVERSITY AVENUE  
E. PALO ALTO, CA 94303-2248

EXAMINER

BLACKWELL, JAMES H

ART UNIT

PAPER NUMBER

2176

MAIL DATE

DELIVERY MODE

11/14/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/763,642

Applicant(s)

HOWELL, DAVID

Examiner

James H. Blackwell

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/15/2007 has been entered.
2. In the Response dated 10/15/2007, Applicant argued against the 103 rejections set forth in the Final Rejection dated 10/13/2006. In light of Applicant's remarks, all 103 rejections previously set forth are withdrawn.
2. Claims 1-36 remain pending. Claims 1, 13, and 25 are independent claims.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7, 10, 13-19, 22, 25-3, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al. (hereinafter Clark, U.S. Patent No. 6,704,733 filed 09/26/2001, issued 03/09/2004) in view of Sena et al. (hereinafter Sena, U.S. Patent No. 7,039,643 filed 04/10/2001, issued 05/02/2006).

**In regard to independent Claim 1, Clark discloses:**

- *A system for collecting and distributing an edition of a work (Abstract → a method for receiving, processing, and distributing electronic content), comprising:*
  - *an input module that receives an input file in a particular format (Col. 3, line 62 through Col. 4, line 42; Fig. 4; Col. 6, lines 47-54; Fig. 12 → a publisher transmits content over a network to a server for subsequent electronic distribution and/or hard copy printing. In addition to content, the server can also receive metadata corresponding to the content. Inputted content can be in a variety of formats such as PDF, PostScript, QuarkXpress, etc.), the input module further comprising*
    - *a module that validates the input file (Col. 6, line 63 through Col. 7, line 7 → after receiving the content and metadata, the process (240) automatically checks (pre-flights) (validates) the content for numerous issues which might prevent accurate automatic preparation of a title (a work)).*

**Clark fails to disclose:**

- *converts the input file into an intermediate format file. Clark keeps the input file format and merely converts that to a desired output format.*

However, Sena discloses *converts the input file into an intermediate format file* (Abstract; Fig. 10 → Sena generally discloses a digital media file conversion and integration system (as well as a publication/distribution system)

including a server coupled to the Internet to allow users to download media files to a server the Internet. The system contains devices to screen, compress, and update the media files, devices to break down the media files into low level components, devices to *convert one or media files to an intermediate format* and then combine the intermediate formats to create an output format, devices to convert output formats to a presentation file). The intermediate file format is typically XML (see Col. 12, lines 22-35)).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Clark and Sena as both inventions are related to the authoring, publication, and distribution of content via a processing server and the Internet. Adding the disclosure of Sena provides the benefit of converting authored input files to an intermediate format such that the converted content components are more easily manipulated to construct desired and varied output files.

Clark further discloses:

- *a storage device comprising*
  - *a storage portion into which a piece of work metadata associated with the input file is stored* (Col. 4, lines 20-22, Fig. 4 → server contains a content management system that stores and processes the received content and metadata).

Clark fails to disclose:

- *a storage device comprising*

- *a storage portion that stores the intermediate format file.* Clark does not disclose the conversion of input files to an intermediate format.

However, Sena discloses *a storage device comprising a storage portion that stores the intermediate format file* (Col. 8, lines 49-58 → The system includes a publishing manager module (450) which controls and schedules the entire process of converting, integrating and publishing and distributes the digital media files (410), (412), and (414), and (415) between the modules, *temporary file storage* (418), and a digital media input handler module (420). The system also includes a digital media transformation module (460), a device-building module (480), an output communications device (490), *a data storage* (492), an optional network server (496) connected to an email delivery device (494) or an Internet connection (498). Files, and accompanying metadata, are stored initially when input to the system to check them for viruses. The file conversion to intermediate files also has storage for the intermediate files).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Clark and Sena as both inventions are related to the authoring, publication, and distribution of content via a processing server and the Internet. Adding the disclosure of Sena provides the benefit of storing intermediate format files such that the converted content components are accessible to the system to be manipulated to construct desired and varied output files.

Clark continues by disclosing:

- *a conversion module that generates two or more editions of a work having different formats, the two or more editions of the work being generated based on the intermediate format file and the work metadata (Col. 4, lines 12-19; lines 55-61; Col. 7, lines 8-67 → the system can produce both hardcopy (print on demand) and electronic versions of output based on the input files and their associated metadata, where the metadata includes content about the publication as well as Digital Rights Management and publication instructions).*

As previously noted, Clark's "*intermediate format files*" are simply the input files themselves, while, as previously disclosed above, Sena converts its input files to an intermediate format (e.g., XML).

**In regard to dependent Claim 2, Clark discloses:**

**Note:** the Specification defines "work metadata" as consisting of a combination of metadata related to the work itself and metadata related to the "final forms that the Work might assume (form metadata)." Thus, the examiner considers the "work metadata" to be metadata that is related to style, format, and/or layout.

- *the storage device further comprises a storage portion that stores a piece of form metadata associated with the intermediate format file, the form metadata specifying a form of an edition of the work (Col. 2, lines 15-22 → the method includes storing the metadata with metadata associated with other received electronic content, selecting metadata from the stored metadata that corresponds*

to electronic content authorized for a retailer, and storing at least a portion of the selected metadata for transmission to the retailer over the network in accordance with formatting information received from the retailer). (Col. 3, lines 2-13 → The metadata can include identifier information such as the ISBN, UPC or DOI of the work; pricing information for one or more markets in which the work may be sold; bibliographic information such as the author and title of the work; distribution information such as identification of territories where selling the work is authorized, retailers authorized to sell the work, and/or identification of one or more digital rights management systems for protecting the work when distributed electronically; and/or *manufacturing information, such as a printing and/or binding specifications, for use in the preparation of hard copies of the work* ("form metadata").

**In regard to dependent Claim 3, Clark discloses:**

- *a distribution module that distributes the one or more editions of the work* (Fig. 3 → discloses a distribution mechanism for the system).

**In regard to dependent Claim 4, Clark discloses:**

- *a plurality of distribution channels, wherein each distribution channel receives a different edition of the work* (Col. 7, lines 7-33 → describe distribution path for a hard copy distribution of a work. Col. 7, lines 34-62 → describe a distribution path for an electronic version of a work (e.g., e-book)).



**In regard to dependent Claim 5, Clark, discloses:**

- *the distribution module further comprises a web site into which the one or more editions of the work are loaded wherein the one or more editions of the work are available for download from the web site (Col. 9, lines 45-47 → the server may provide a web site for distribution of works, though it is usually handled by another party).*

**In regard to dependent Claim 6, Clark discloses:**

- *the distribution module distributes the one or more editions of the work to a wireless device (Col. 9, lines 45-47 → the server may provide a web site for distribution of works, though it is usually handled by another party). Clark does not explicitly disclose distribution to a “wireless” device. However, since Clark can distribute content via a web site, and also contemplates the electronic distribution of content to a variety of devices including PDA and cell phones (see Col. 1, lines 21-36), many of which were known to those of ordinary skill in the art at the time of invention to have the ability to communicate wirelessly to web sites, one of ordinary skill in the art at the time of invention would conclude that Clark would have been able to distribute content wirelessly, providing the benefit of instantaneous access to desired content from a web site.*

**In regard to dependent Claim 7, Clark discloses:**

- *the distribution module distributes the one or more editions of the work over a Bluetooth communications link* Col. 9, lines 45-47 → the server may provide a web site for distribution of works, though it is usually handled by another party). Clark does not explicitly disclose distribution to a “wireless” device over “Bluetooth link”. However, since Clark can distribute content via a web site, and also contemplates the electronic distribution of content to a variety of devices including PDA and cell phones (see Col. 1, lines 21-36), many of which were known to those of ordinary skill in the art at the time of invention to have the ability to communicate wirelessly (e.g., via normal cellular wireless means, and Bluetooth), one of ordinary skill in the art at the time of invention would conclude that Clark would have been able to distribute content wirelessly, providing the benefit of instantaneous access to desired content from a web site.

**In regard to dependent Claim 10, Clark discloses:**

**Note:** the Specification defines “work metadata” as consisting of a combination of metadata related to the work itself and metadata related to the “final forms that the Work might assume (form metadata).” Thus, the examiner considers a “subset” of “work metadata” to be a portion of metadata that relates to style, format and/or layout.

- *an edition of the work further comprises an edition containing a subset of the work metadata associated with the intermediate format file (Col. 7, line 63 through Col. 9, line 43 → discusses various incorporations of metadata to accompany a given title in a selected distribution format).*

**In regard to Claims 13-19, and 22,** Claims 13-19, and 22 merely recite a computer-implemented method for operating on the system of Claims 1-7, and 10, respectively. Thus, the combination of Clark and Sena discloses every limitation of Claims 13-19, and 22, as indicated in the above rejections for Claims 1-7, and 10.

**In regard to Claims 25-31, and 34,** Claims 25-31, and 34 merely recite a system for operating on the system of Claims 1-7, and 10, respectively. Thus, the combination of Clark and Sena discloses every limitation of Claims 25-31, and 34, as indicated in the above rejections for Claims 1-7, and 10.

5. Claims 8-9, 20-21, and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Sena, and in further view of Justice (U.S. Patent Application Publication No. 2003/0023635 filed 07/25/2001, published 01/30/2003).

**In regard to dependent Claim 8,** Clark and Sena fail to disclose:

- *a template storage device that stores one or more templates that transform the intermediate format file into an edition of the work.*

However, Justice discloses *a template storage device that stores one or more templates that transform the intermediate format file into an edition of the work* (Fig. 8 → discloses the use of XSLT templates (style sheets) to provide conversion means to transform input/intermediate files to output files in a specific format and style).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Clark, Sena, and Justice as all three inventions are related to the authoring, publication, and distribution of content via a processing server and the Internet. Adding the disclosure of Justice provides the benefit of utilizing XSLT templates to aid in the conversion from an intermediate format to a final output format.

**In regard to dependent Claim 9, Clark and Sena fail to disclose:**

- *the template further comprises an XSLFO style sheet.*

However, Justice discloses *the template further comprises an XSLFO style sheet* (Fig. 8 → discloses the use of XSLT templates (style sheets) to provide conversion means to transform input/intermediate files to output files in a specific format and style). Further, it was well known and obvious to those of ordinary skill in the art at the time of invention that an XSL-FO style sheet is one form of a style sheet akin to an XSLT/XSL style sheet (e.g., see K. Holman, "What is XSL-FO," 03/20/2002, Pg. 3 of 22, describes the relationship of XSL/XSLT/ and XSL-

FO). Though Justice does not explicitly disclose the use of XSL-FO style sheets, Justice does disclose the storage and use of style sheets for processing input or intermediate content to final or output content. Thus, one of ordinary skill in the art at the time of invention would find it obvious to replace XSLT style sheets with XSL-FO style sheets, or to use both together since both would assist in rendering output content to the user.

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Clark, Sena, and Justice as all three inventions are related to the authoring, publication, and distribution of content via a processing server and the Internet. Adding the disclosure of Justice provides the benefit of utilizing XML-related templates (style sheets) to aid in the conversion from an intermediate format to a final output format.

**In regard to Claims 20-21**, Claims 20-21 merely recite a computer-implemented method for operating on the system of Claims 8-9, respectively. Thus, the combination of Clark, Sena, and Justice disclose every limitation of Claims 20-21, as indicated in the above rejections for Claims 8-9.

**In regard to Claims 32-33**, Claims 32-33 merely recite a system for operating on the system of Claims 8-9, respectively. Thus, the combination of Clark, Sena, and Justice disclose every limitation of Claims 20-21, as indicated in the above rejections for Claims 8-9.

6. Claims 11-12, 23-24, and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Sena, and in further view of Barsness et al. (hereinafter Barsness, U.S. Patent Application Publication No. 2004/0201633 filed 09/13/2001, published 10/14/2004).

**In regard to dependent Claim 11, Clark and Sena fail to disclose:**

- *module that collects feedback about the editions of the work that are stored in the storage device.*

However, Barsness discloses *module that collects feedback about the editions of the work that are stored in the storage device* (Pg. 7, Paragraph [0085] → where the content is being created by an instructor, or any other author for that matter, the usage statistics may be utilized in revising the content, e.g., to simplify certain passages, make certain passages more understandable, etc., as shown in block 212. Once the content is revised, the content may optionally be redistributed to users as shown by the arrow from block 212 to block 204. The usage Statistics in this application are therefore utilized to assist an author in improving the quality of authored content based upon the usage statistic feedback generated by one or more users).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine, the disclosures of Clark, Sena, and Barsness as all of these inventions relate to the authoring, publication, and distribution of content via a processing server and the Internet. Adding the teaching of Barsness provides the benefit of providing feedback to authors and publishers about their products' usage.

**In regard to dependent Claim 12, Clark and Sena fail to disclose:**

- *the feedback for an edition further comprises one or more of a number of copies of an edition sold, a sales price of an edition, a geographic distribution of the edition and a demographics of final users of the edition.*

However, Barsness discloses *the feedback for an edition further comprises one or more of a number of copies of an edition sold, a sales price of an edition, a geographic distribution of the edition and a demographics of final users of the edition* (Pg. 7, Paragraph [0085] → discloses the general use of usage statistics or “feedback” between users of content and providers of content. For example, where the content is being created by an instructor, or any other author for that matter, the usage statistics may be utilized in revising the content, e.g., to simplify certain passages, make certain passages more understandable, etc., as shown in block 212. Once the content is revised, the content may optionally be redistributed to users as shown by the arrow from block 212 to block 204. The usage Statistics in this application are therefore utilized to assist an author in improving the quality of authored content based upon the usage statistic feedback generated by one or more users. Barsness does appear to allow for a variety of other feedback from readers of the content and therefore it would have been obvious to those of ordinary skill in the art at the time of invention to conclude that at least demographical or geographic distribution information would be included among these feedbacks since one would have been able to glean such statistics, at least indirectly, from the manner of feedback received from individuals (e.g., the use of more complicated words might

prompt someone who is less educated to provide feedback, where education is a demographic).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine, the disclosures of Clark, Sena, and Barsness as all of these inventions relate to the authoring, publication, and distribution of content via a processing server and the Internet. Adding the teaching of Barsness provides the benefit of providing feedback to authors and publishers about their products' usage.

**In regard to Claims 23-24**, Claims 23-24 merely recite a computer-implemented method for operating on the system of Claims 11-12, respectively. Thus, the combination of Clark, Sena, and Barsness disclose every limitation of Claims 23-24, as indicated in the above rejections for Claims 11-12.

**In regard to Claims 35-36**, Claims 35-36 merely recite a system for operating on the system of Claims 11-12, respectively. Thus, the combination of Clark, Sena, and Barsness disclose every limitation of Claims 35-36, as indicated in the above rejections for Claims 11-12.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-36 have been considered but are moot in view of the new ground(s) of rejection.



***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on 8-4:30 M-F.
9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James H. Blackwell  
11/07/2007

*/Doug Hutton/*  
Doug Hutton  
Supervisory Primary Examiner  
Technology Center 2100